

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK A. DIESCH

Appeal No. 98-3287
Reissue Application 08/354,624¹

ON BRIEF

Before NASE, CRAWFORD and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's

¹Application filed December 13, 1994, for reissue of U.S. Patent No. 5,094,224, issued March 10, 1992, based on application 07/661,493, filed February 26, 1991.

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final rejection of claims 1 through 23 in this reissue application of Patent No. 5,094,224. These claims constitute all of the claims pending in this application.

Appellant's invention relates to a heat exchanger tube for a furnace. An understanding of the invention can be derived from a reading of exemplary claims 1, 7 and 19 which have been reproduced in the "Appendix" to appellant's Brief (Paper No. 16).²

THE REFERENCES

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Tomlinson	4,739,746	Apr.
26, 1988		
Thomae	3,413,999	Nov. 07,
1985 (German Patent) ³		

THE REJECTIONS

The following rejections are before us for review:

² We note the following error in claim 19 as reproduced in the "Appendix": line 13, --of-- should be inserted after "each."

³ Our consideration of this reference is based on an English translation thereof, a copy of which is provided to appellant with this decision.

(1) Claims 1 through 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tomlinson in view of Thomae; and

(2) Claims 1 through 23 stand rejected under 35 U.S.C. § 251 as being based on a defective reissue declaration.⁴

The rejections are explained in the Examiner's Answer (Paper No. 17).

The opposing viewpoints of the appellant are set forth in appellant's Brief and the Reply Brief (Papers Nos. 16 and 18).

OPINION

We shall not sustain the examiner's § 103 or § 251 rejection of claims 1 through 23. With respect to all of the appealed claims, we enter a new ground of rejection under the provisions of 37 CFR 1.196(b). We begin with the new ground of rejection.

Claims 1 through 23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite and hence failing to

⁴ The final rejection also included a rejection of claims 1 through 23 under 35 U.S.C. § 103 based on Tomlinson in view of Kerivan. However, that particular rejection has been withdrawn (answer, page 5).

particularly point out and distinctly claim the subject matter which appellant regards as his invention.

Our difficulty with the claim language centers on the word "substantial" in the phrase "a substantial axial portion of said elongated tube" in each of independent claims 1, 7 and 19.

When a word of degree such as "substantial" is used in a claim, it must be determined whether the underlying specification provides some standard or guideline for measuring that degree.

In other words, it must be determined whether one of ordinary skill in the art would understand what is claimed when the claim

is read in light of the specification. Seattle Box Co. v. Industrial Crating & Packing Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

In the present case, appellant's specification does not provide any standard or guidance for determining what percentage of the total length of the elongated tube the flue

and enhanced portions must be in order to be considered "a substantial axial portion of said elongated tube." In fact, the specification as filed does not even state that the flue and enhanced portions extend a substantial axial portion of the elongated tube. Thus, the only disclosure concerning the lengths of the flue and enhanced portions is found in the application drawings.

However, like the specification, appellant's drawings offer no meaningful guidance to determine what percentage of the total length of the elongated tube the flue and enhanced portions must be in order to be considered a substantial axial portion of the elongated tube. In the embodiment illustrated in Figures 1-3, the tube 22 includes flue portion 30, bend portion 32 and enhanced portion 34. In Figure 18, the tube 50 includes flue portion 56, bend portion 58 and enhanced portion 60. In each of the illustrated embodiments, the flue portion extends less than

50% of the total length of the elongated tube and the flattened enhanced portion appears somewhat shorter than the flue portion.

We would expect the meaning of "a substantial axial portion of said elongated tube" to have the same meaning with respect to the flue portion and to the enhanced portion, but appellant's drawings show the flue portion to be longer than the enhanced portion and suggest that the expression has a different meaning with respect to each of the different portions. Thus, when read in light of the showing in Figures 1-3 and 18, the recitation that the flue portion and the enhanced portion each extend "a substantial axial portion of said elongated tube" becomes even more confusing.

For the foregoing reasons, one of ordinary skill in the art would not understand the scope of the claimed subject matter when read in light of appellant's specification. Accordingly, the Seattle Box test discussed supra has not been met.

In the final analysis, claims 1, 7 and 19 and, consequently, the claims which depend directly or indirectly therefrom do not define the metes and bounds of the invention

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with a reasonable degree of precision as required in In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

In some instances, it is possible to make a reasonable, conditional interpretation of claims adequate for the purpose of resolving patentability issues to avoid piecemeal appellate review. In the interest of administrative and judicial economy, this course is appropriate wherever reasonably possible. See Ex parte Saceman, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993); Ex parte Ionescu, 222 USPQ 537, 540 (Bd. App. 1984). In other instances, however, it may be impossible to determine whether or not claimed subject matter is anticipated by or would have been obvious over references because the claims are so indefinite that considerable speculation and assumptions would be required regarding the meaning of terms employed in the claims with respect to the scope of the claims. See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962).

For the reason discussed above, we consider appellant's claim 1 through 23 to be sufficiently indefinite that application

of the references to the claims is not possible. On this basis,

we will not sustain the rejection under 35 U.S.C. § 103. It should be understood that this reversal is not a reversal on the merits of the rejection, but rather is a procedural reversal predicated upon the indefiniteness of the claims.

We will also not sustain the rejection of claims 1 through 23 under 35 U.S.C. § 251. The reason given by the examiner for

the rejection is that "the oath/declaration [fails] to address how and why the presently amended claims remain patentable by correcting the alleged errors over the references" (answer, page 5). At the time the examiner's answer was mailed, neither § 251 nor the rules required the reissue oath or declaration to explain how or why the reissue claims were patentable. However, the rules did require the reissue oath or declaration to particularly specify "the errors relied

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upon, and how they arose or occurred." 37 CFR § 1.175(a)(5) (1996). Our review of the reissue declaration filed on December 13, 1994, reveals that it contains paragraphs 2A through 2L which identify the errors relied upon by appellant. The examiner's answer does not contain a well-reasoned argument for supporting the rejection and we know of none. Accordingly, we will not sustain the standing rejection under § 251.⁵

CONCLUSION

To summarize our decision, we have reversed the examiner's rejection of claims 1 through 23 under 35 U.S.C. § 251 on the merits. In addition, we have reversed the examiner's rejection of

claims 1 through 23 under 35 U.S.C. § 103 on a procedural ground predicated upon the indefiniteness of the claims and,

⁵ The requirements of 37 CFR § 1.175 were amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997). Any further determination of the adequacy of the reissue declaration must be based on 37 CFR § 1.175, as amended effective Dec. 1, 1997.

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pursuant to 37 CFR § 1.196(b), we have entered a new ground of rejection against claims 1 through 23 under 35 U.S.C. § 112, second paragraph.

In view of the above, the decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED/196(b)

JEFFREY V. NASE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MURRIEL E. CRAWFORD)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JOHN F. GONZALES)	
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